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TraskBritt		EXAMINER		
PO Box 2550		SODERQUIST, ARLEN		
Salt Lake, UT 84110				
		ART UNIT	PAPER NUMBER	
		1743		
DATE MAILED: 05/17/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/048,244

**Applicant(s)**

BLUMENTHAL, DONALD K.

**Examiner**

Arlen Soderquist

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific compounds disclosed, does not reasonably provide enablement for a scope covering all doubly labeled compounds that have at least a part of their fluorescence quenched through ground state interactions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. To meet the claim limitations, it requires at least four things to be present: a molecular backbone, a group or position in the backbone capable of being covalently modified that causes a change in the conformation of the molecule, a fluorescent dye and a second dye that are both covalently bonded to the molecular backbone in a configuration that the second dye quenches the fluorescence of the fluorescent dye through a ground state interaction before covalent modification of the molecule and allows fluorescence after covalent modification of the molecule. In the examples shown the molecule includes five parts, a sequence that includes the chemical modification site (the phosphorylation site, an extension of the sequence at the C-terminus, an additional extension of the sequence at the N-terminus and the two dyes at the resulting C- and N-terminus locations. What applicant has not shown is if another structure having more or fewer amino acids in the sequence will work. Also not shown is if the added labels can be added at any location of the sequence and still work. The specification alleges that other similar sequences can be made for other enzymes, however no actual examples were given. Additionally the specification does not present fluorescence lifetime data that appears to be the accepted way of determining the amount of fluorescence or fluorescence quenching due to the various processes possible (see the newly cited Lakos and Sillen references). As evidence of the predictability problems that this causes, applicant is directed to the newly cited Schobel reference. In this reference a donor-acceptor dye pair (Cy5 and Cy5.5) are taught. This dye pair is a resonance energy transfer (RET) dye pair having almost perfect overlap of the Cy5 emission and the Cy5.5 absorption spectrum. However, in at least one embodiment of the pair about only 50% of the quenching results from resonance energy transfer and the remaining quenching is due to static (ground state) quenching processes. From this it either appears that the presence of ground state quenching mechanisms is either quite prevalent in the resonance energy transfer dye pairs or cannot be determined or designed with any high level of repeatability or expectation. In other words the reference shows

that there is either a high level of expectation of the presence of ground state quenching interactions occurring or there is a low predictability of when these interactions will be present in any given dye pair/molecular configuration. An additional difficulty with the claimed molecules is that the molecule must have the ability to be covalently modified leading to a configuration change that will cause a change in the ground state quenching mechanisms. All of the dye combinations found in the dependent claims can be used in situations in which there is FRET involved as evidenced by the arguments against the references applied against the claims. Thus designing a compound that is non-FRET quenched is not an easy task if the scope of FRET interactions includes both the respective dyes and backbones that are available for use. Because of this problem the examination will treat a reference teaching all but the presence of ground state quenching mechanisms as inherently anticipatory of the claims that it otherwise discloses. Particularly if the dye combination is within the scope claimed. Additionally applicant has not shown that their own work has produced compounds beyond that exemplified in the specification or that others have either on their own or as a benefit of applicant's teachings, developed compounds within the instant claim scope that are not exemplified in the instant specification.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2, 5-7, 9, 11, 15 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Odom. In the paper Odom discusses an apparent conformational change in phenylalanine transfer RNA that is associated with the peptidyl transferase reaction. Fluorescence techniques were used to detect changes in the conformation of tRNA<sup>Phe</sup> that may occur during the peptidyl transferase reaction in which the tRNA appears to move between binding sites on ribosomes. Such a conformational change may be a fundamental part of the translocation mechanism by which tRNA and mRNA are moved through ribosomes. Escherichia

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coli tRNA<sup>Phe</sup> was specifically labeled on acp<sup>3</sup>U<sub>47</sub> and s<sup>4</sup>U<sub>8</sub> or at the D positions 16 and 20. The labeled tRNAs were bound to ribosomes as deacylated tRNA<sup>Phe</sup> or AcPhe-tRNA. Changes in fluorescence quantum yield and anisotropy were measured upon binding to the ribosomes and during the peptidyl transferase reaction. In one set of experiments *non-radiative energy transfer was measured between a coumarin probe at position 16 or 20 and a fluorescein attached to acp<sup>3</sup>U<sub>47</sub> on the same tRNA<sup>Phe</sup> molecule.* The results indicate that the apparent distance between the probes increases during deacylation of AcPhe-tRNA as a result of peptide bond formation. All of the results are consistent with but in themselves do not conclusively establish that tRNA undergoes a conformational change as well as movement during the peptidyl transferase reaction. See the various tables and results and discussion sections. In particular page 933 discusses how the fluorescence of the coumarin label changes as the environment of the singly labeled substrate changes. Also pages 934-935 discuss the energy transfer and its use in determination of conformational changes in molecules by measuring changes in the distance between the two labels of the substrate. The two labels exemplified are instantly claimed in claims 5-6.

4. Claims 1-2, 5-7, 9, 11, 15 and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gilda (US 6,485,901). In the patent Gildea teaches methods, kits and compositions of Linear Beacons containing energy-transferring donors and acceptors and their use in nucleic acid hybridization. Linear Beacons are polymers containing donor and acceptor moieties separated by a nucleobase sequence. The polymers do not necessarily form a stem-loop hairpin. The efficiency of energy transfer between the donor and acceptor moieties is substantially independent of at least two of the following variables: sequence length, spectral overlap of donor and acceptor, presence or absence of Mg, and ionic strength of the solution. Preferred linear beacons are fluorophore-containing peptide nucleic acids (PNAs). In the absence of a target sequence, Linear Beacons facilitate efficient energy transfer between the donor and acceptor moieties linked to opposite ends of the probe. Upon hybridization of the probe to a target sequence, there is a measurable change in at least one property of at least one donor or acceptor moiety of the probe which can be used to detect, identify or quantitate the target sequence in a sample. Experiments demonstrating the non-FRET behavior of the PNA Linear Beacons and their use in detection of *Pseudomonas aeruginosa* and *Bacillus subtilis* as

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well as detection of PCR-amplified K-ras gene were demonstrated. Tables 1B and 1C show Linear Beacons prepared. The structure of column 12 includes several covalently modifiable groups.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blumenthal in view of Odom as explained above and Tyagi (either (WO 97/39008 or US 6,150,097). In the paper Blumenthal reviews the development and characterization of fluorescently-labeled myosin light chain kinase calmodulin-binding domain peptides. The development and characterization of peptides based on the sequence of the calmodulin-binding domain of skeletal muscle myosin light-chain kinase which were labeled with the fluorescent reagent, acrylodan are described. The use of these fluorescently-labeled peptides to study various aspects of calmodulin-peptide interactions including binding affinity, stoichiometry, specificity, changes in peptide conformation, and thermal stability of the peptide-calmodulin complex is demonstrated. Page 46 discusses the preparation of analogs by replacing different amino acids within a natural peptide sequence to examine these properties. Blumenthal also teaches the formation of a library of peptides with different fluorescent labels. Page 46 also discusses the change in the acrylodan fluorophore as the environment changes and how this is useful in determining various properties. The peptides exhibit many of the salient features seen with calmodulin-target enzyme interactions. The fluorescently-labeled peptides should serve as useful models for studying

calmodulin-target enzyme interactions at the molecular level. Blumenthal does not teach the use of a substrate that is doubly labeled with labels that have at least a part of their energy transfer through non-radiative pathways.

Since the Tyagi US Patent is a continuation of the application that resulted in the WO publication, only the US Patent will be discussed by reference the parts of the reference. In the patent Tyagi teaches detection of probes in nucleic acid hybridization using non-fluorescence resonance energy transfer (non- FRET) pairs of chromophores. Nucleic acid hybridization probes are described having a first conformation when not interacting with a target and a second conformation when interacting with a target, and having the ability to bring a label pair into touching contact in one conformation and not the other, are labeled with a non-FRET pair of chromophores and generate a fluorescent or absorbance signal. As opposed to FRET, quenching molecules and even other fluorophores can serve as efficient quenching moieties for fluorophores when attached to nucleic acid hybridization probes such that the fluorescing moiety and quenching moiety are in contact, even when the rules of FRET are violated. To demonstrate probes with "touching" pairs of a fluorophore with another fluorophore or quencher, where the pairs are not FRET pairs, fluorescence quenching efficiency was measured where Molecular Beacon probes were end-labeled with DABCYL at one end and one of 8 different fluorophores at the other end. DABCYL could quench the fluorescence of fluorescein, Lucifer Yellow, BIDIPY, eosine, erythrosine, tetramethylrhodamine, Texas Red, and coumarin. Effective fluorophore quenching also occurred in non-FRET pairs containing other quenchers, DABMI and Malachite Green, as well as appropriate (shorter wavelength) fluorophores such as coumarin. The utility of fluorophore-quencher combinations is demonstrated in a multiplex detection assay using 4 different nucleic acid targets. Columns 1-3 discuss the use of FRET labeled substrates in the prior art and notes that a disadvantage is related to the requirement for overlap between the labels in order to produce the desired affect. Columns 3-4 discuss the advantages of the non-FRET label pairs in that they do not require the overlap of FRET pairs and can therefore provide measurable results or enhancement even when FRET results are not possible.

It would have been obvious to one of skill in the art at the time of the invention to incorporate a double label selected from those taught by Odom or Tyagi in the Blumenthal substrates for their recognized ability to determine conformational changes and work in situation

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that FRET label pairs or single labels are not able to provide that information as taught by Odom and Tyagi.

7. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Macala, Schultz (US 5,580,747) or Ventura in view of Blumenthal and Odom or Tyagi as explained above.

In the paper Macala teaches measurement of cAMP-dependent protein kinase activity using a fluorescent-labeled Kemptide. Traditional protein kinase assays include the use of  $^{32}\text{P}$ -labeled ATP as phosphate donor and a substrate protein or peptide as phosphoreceptor. Since this approach has a number of drawbacks in addition to generating ionizing radiation, several non-isotopic methods have been developed. Although shown to reflect the activity of purified enzymes, none have been demonstrated to detect physiological changes in endogenous enzyme activity in cell homogenates. Studies were performed to examine the kinetics, reproducibility, and optimal assay conditions of a novel non-radioisotopic kinase assay that detects protein kinase A (PKA) activity by phosphorylation of the peptide substrate, Kemptide, covalently bound to a fluorescent molecule (fluorescamine-labeled Kemptide; f-Kemptide). Fluorescence was determined by spectrofluorometry with excitation at 568 nm and emission at 592 nm. Basal and agonist-induced PKA activities in epithelial cell homogenates were measured. The kinetics of f-Kemptide were similar to the standard radioisotopic method with intra-assay and inter-assay variations of  $5.6 \pm 0.8\%$  and  $14.3 \pm 2.6\%$ , respectively. Neither fluorescence quenching nor enhancing effects were found with consistent amounts of homogenate protein. Specific PKA activity was determined as the IP20-inhibitable fraction to account for nonspecific phosphorylation, perhaps due to S6 kinase or a similar enzyme. The basal activity of 38% of total PKA in A6 cells increased by 84% after exposure to vasopressin and by 58% after short exposure to forskolin. In T84 cells exposed to VIP there was a 360% increase over basal activity. These results show that f-Kemptide exhibits acceptable kinetics, and that the assay system can quantitatively and reproducibly measure basal and stimulated PKA activity in cell homogenates. Macala does not teach the substrate having two dyes attached or a library of compounds.

In the patent Shultz teaches a non-radioactive assay and purification of proteins, and particularly to the non-radioactive assay and purification of protein kinases, phosphatases and



protease by incubating the enzyme with a substrate modified peptide to form a product modified peptide under conditions where the enzyme is active. The product modified peptide and substrate modified peptide are then separated, and the product modified peptide is measured. The present invention is also directed to kits and bioreagents for performing the assays. Table 1 of the patent shows a list of substrates that have a fluorescent dye attached to the substrate. Shultz does not teach the substrate having two dyes attached or a library of compounds.

In the paper Ventura teaches phorbol ester regulation of opioid peptide gene expression in myocardial cells and the role of nuclear protein kinase C. Opioid peptide gene expression was characterized in adult rat ventricular cardiac myocytes that had been cultured in the absence or the presence of phorbol 12-myristate 13-acetate. The phorbol ester induced a concentration- and time-dependent increase of prodynorphin mRNA, the maximal effect being reached after 4 hours of treatment. The increase in mRNA expression was suppressed by incubation of cardiomyocytes with staurosporine, a putative protein kinase C inhibitor, and was not observed when the cells were cultured in the presence of the inactive phorbol ester 4a-phorbol 12,13-didecanoate. Incubation of cardiac myocytes with phorbol 12-myristate 13-acetate also elicited a specific and staurosporine-sensitive increase in immunoreactive dynorphin B, a biologically active end product of the precursor, both in the myocardial cells and in the culture medium. In vitro run-off transcription assays indicated that transcription of the prodynorphin gene was increased both in nuclei isolated from phorbol ester-treated myocytes and in nuclei isolated from control cells and then exposed to phorbol 12-myristate 13-acetate. No transcriptional effect was observed when cardiac myocytes or isolated nuclei were exposed to 4a-phorbol 12,13-didecanoate. The phorbol ester-induced increase in prodynorphin gene transcription was prevented by pretreatment of myocytes or isolated nuclei with staurosporine, suggesting that myocardial opioid gene expression may be regulated by nuclear protein kinase C. In this regard, cardiac myocytes expressed protein kinase C- $\alpha$ , - $\delta$ , - $\epsilon$ , and - $\zeta$ , as shown by immunoblotting. Only protein kinase C- $\delta$  and protein kinase C- $\epsilon$  were expressed in nuclei that have been isolated from control myocytes, suggesting that these 2 isotypes of the enzyme may be part of the signal transduction pathway involved in the effect elicited by the phorbol ester on opioid gene transcription in isolated nuclei. The incubation of myocardial nuclei isolated from control cells

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in the presence of a protein kinase C activator induced the phosphorylation of the myristylated alanine-rich protein kinase C substrate peptide, a specific fluorescent substrate of the enzyme. The possibility that prodynorphin gene expression may control the heart function through autocrine or paracrine mechanisms is discussed. Ventura does not teach the substrate having two dyes attached or a library of compounds.

In the paper Blumenthal reviews the development and characterization of fluorescently-labeled myosin light chain kinase calmodulin-binding domain peptides. The development and characterization of peptides based on the sequence of the calmodulin-binding domain of skeletal muscle myosin light-chain kinase which were labeled with the fluorescent reagent, acrylodan are described. The use of these fluorescently-labeled peptides to study various aspects of calmodulin-peptide interactions including binding affinity, stoichiometry, specificity, changes in peptide conformation, and thermal stability of the peptide-calmodulin complex is demonstrated. Page 46 discusses the preparation of analogs by replacing different amino acids within a natural peptide sequence to examine these properties. Blumenthal also teaches the formation of a library of peptides with different fluorescent labels. Page 46 also discusses the change in the acrylodan fluorophore as the environment changes and how this is useful in determining various properties. The peptides exhibit many of the salient features seen with calmodulin-target enzyme interactions. The fluorescently-labeled peptides should serve as useful models for studying calmodulin-target enzyme interactions at the molecular level.

It would have been obvious to one of skill in the art at the time of the invention to incorporate a double label selected from those taught by Odom or Tyagi in the Macala, Shultz or Ventura substrates because of the ability to detect conformational changes in the substrate due to covalent modifications of the substrates as shown by Odom and Tyagi. One of skill in the art would also have recognized that libraries of substrates as taught by Blumenthal would have allowed the Macala, Shultz or Ventura substrates to be used for characterizing enzyme properties as shown by Blumenthal.

8. Applicant's arguments filed February 21, 2006 have been fully considered but they are not persuasive. Relative to the lack of enablement, examiner points out that the expectation of success is a relative thing. In the instant case, the expectation of success is dependent on a number of things. These include the fact that the dye combination can be involved in molecules

that involve both FRET and non-FRET quenching. To meet the claim limitations, it requires at least four additional things to be present: a molecular backbone, a group or position in the backbone capable of being covalently modified that causes a change in the conformation of the molecule, a fluorescent dye and a second dye that are both covalently bonded to the molecular backbone in a configuration that the second dye quenches the fluorescence of the fluorescent dye through a ground state interaction before covalent modification of the molecule and allows fluorescence after covalent modification of the molecule. Variables in this system include the form or structure of the backbone, the positioning of the two dyes along the backbone and the dye combinations used. The backbone must have two things a structure that has at least two possible conformations and a portion of the backbone that is modifiable without cleavage of the backbone to control which conformation is present. The instant claims do not limit the form of the backbone and include biological types of structures as well as non-biological structures. The next level of difficulty is added with the placement of two dyes along the backbone at positions that they will interact (include quenching) in one configuration of the backbone and not interact in the second configuration of the backbone. The third level of difficulty comes in that not only must the dyes interact, but they must interact with at least some degree of non-FRET quenching present. If every dye combination has the presence of non-FRET quenching, then this is not a difficult problem. It is not this basis that the art rejections are based. If the presence of non-FRET quenching requires that the dyes have a certain or specific structural relationship for non-FRET quenching to occur, then not every position along a molecular backbone will be capable of producing the proper conditions or configuration for the non-FRET quenching to occur. Focusing more on the embodiments shown, there are a number of sequences that are known to be susceptible to modification by a phosphorylating enzyme. However, how many of these sequences would be expected by one of ordinary skill in the art to be modifiable to include the two dyes needed and include a change in conformation that is capable of causing the two dyes to have an interaction that includes non-FRET quenching in one of the conformations and the absence of that quenching in the second conformation. If a non-FRET quenching requires the dyes to have a specific structural relationship, how easy is it to predict which of the many possible sites to attach the two dyes will lead to a configuration that will produce the non-FRET quenching rather than the FRET quenching which always appears to be a possibility. In other

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words it appear that FRET quenching is more likely than non-FRET quenching. This clearly decreases the expectation that non-FRET quenching will be present. It appears that a large number of potential sequences will lead to only a few compounds that meet the requirements of the claims. Additionally it appear that the effort to find compounds that meet the claim requirements is great with little expectation of success. Thus it appears that even in spite of the few examples shown in the specification, the discovery of additional molecules that work requires a large amount of trial and error work. Thus the specification is not enabled for the scope that is claimed. Additionally applicant has not shown that their own work has produced compounds beyond that exemplified in the specification or that others have, as a benefit of applicant's teachings, developed compounds within the instant claim scope that are not exemplified in the instant specification.

The cited Schobel reference shows that either one of two things are possible. The first is that even in situation in which the donor-acceptor pair of dyes are designed for efficient FRET quenching (nearly total spectral overlap), there are ground state interactions (static effects) that lead to a part of the quenching that occurs. This would lead one to an expectation of an inherent presence of a ground state interaction that is responsible for at least a part of the quenching that occurs. Thus there is at least an expectation that there is ground state interactions involved in the quenching of Odom. Additionally, the dyes of Odom are clearly found in the listing of dyes found in claims 5-6. This also would have led one in the art to an expectation of the presence of a ground state interaction that is involved in at least a part of the quenching. The second possibility is that the presence of ground state interactions that lead to quenching are not predictable. Particularly when coupled with a covalent modification of the molecule that is required to change the conformation of the molecule and as a result change the amount of quenching that occurs. Relative to the first possibility, if applicant's invention is the discovery of the ground state interactions involved in a known quenching process, then the claims should be limited to molecules that are not known or obvious that which is known. Relative to the second possibility, due to the unpredictability of the presence of ground state interactions and the limited number of examples in the instant specification, the claims should be limited to those that are exemplified as actually working in the instant specification.

Relative to the combination of references, examiner agrees that those references not used as anticipatory references do not anticipate the claims. Examiner also points out that even though applicant may have recognized another advantage which would flow naturally from following the suggestion of the prior art, this cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In other words, if the modification suggest as being obvious by a combination of references has additional reasons for making the modification that applicant has discovered, the obviousness of the combination does not change. The above discussion regarding the presence of ground state interactions that cause quenching in molecules designed for FRET quenching is also relevant to the obviousness of the claims. Additionally the Tyagi reference clearly shows advantages of using non-FRET label pairs. Thus there is sufficient teachings in the applied references to either anticipate or obviate the claims.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arlen Soderquist whose telephone number is (571) 272-1265. The examiner's schedule is variable between the hours of about 6:30 AM to about 5:00 PM on Monday through Thursday and alternate Fridays.

A general phone number for the organization to which this application is assigned is (571) 272-1700. The fax phone number to file official papers for this application or proceeding is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Arlen Soderquist", with a stylized flourish at the end.

Arlen Soderquist  
Primary Examiner